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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,640	11/28/2001	Akio Nodera	214711US0XPCT	5639
22850	7590	10/15/2003		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,640

Applicant(s)

NODERA ET AL.

Examiner

Tae H Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what additional species are allowed into the genus of the terminology modified by "type". The word "type" in claims 1 and 3 therefore makes the modified terminology indefinite. See *Ex parte Copenhagen*, POBA, 1955, 109 USPQ 118-119.

The recited silicone compound in claim 4 lacks an antecedent basis in claim 1. Also, claim 4 is indefinite in not specifying particular functional groups for "R¹".

Amended claims 3-8 are confusing since they are not based on the originally filed claims, and are related to claims 4-9. Clarification is needed.

The following art rejection is based on the amended claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 5-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Laughner et al (EP 0289 828).

Laughner et al teach fire retardant impact modified polycarbonate composition having a potassium paratolylsulfimide or potassium bisulfate, a core/shell polymer (Paraloid 3607) and PTFE in examples 1-8. PTFE forming a fibrillar structure (page 3, lines 38-39) has the instant molecular weight inherently. Said polycarbonate having molecular weight of 22,000 (CALIBRE 300, page 4, lines 52-53) and core/shell polymer (Paraloid 3607) inherently meets the instant viscosity-average molecular weight and rubbery content, respectively. Molded articles having excellent electrical properties are taught at page 2, lines 9-10. Example C containing methacrylate/styrene grafted butyl acrylate meets the original claim 3 (amended claim 3 is different from the original claim 3 though).

Thus, the instant invention lacks novelty.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as obvious over Laughner et al (EP 0289 828) and Bialous et al (US 3,971,756) or Serzawa (EP 0 902 060).

The instant invention further recites employing an organopolysiloxane over Laughner et al. However, Laughner et al teach employing other common additives at page 4, lines 42-45. Bialous et al teach the use of a siloxane in polycarbonate compositions to prevent dripping at col. 1, lines 26-49, and Serzawa teach the use of a

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elastomer (page 23, lines 15-22, page 24, lines 14-22 and page 26, lines 1-3) are taught. Said PTFE has the instant molecular weight inherently, and polycarbonate having a melt flow rate of 14 (page 25, lines 28-30) inherently meets the instant viscosity-average molecular weight.

The instant invention further recites 0.2 to 10 parts by weight of a core/shell elastomer. However, Ogoe et al teach said core/shell elastomer being an optional component as an impact modifier at page 18, lines 14-16. Laughner et al teach employing 0.1 to 10 wt. Percent of a impact modifier at page 4, lines 24-25. Various molded articles are taught at page 1, Summary of the Invention.

It would have been obvious to one skilled in the art at the time of invention to utilize the instant amount of a core/shell elastomer in examples of Ogoe et al since the use of such amount of an impact modifier in polycarbonate compositions depending on the desired final impact strength is well known as taught by Laughner et al.

Claims 1, 3 and 5-8 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Liu (US 4,710,534).

Liu teaches flame retardant impact modified polycarbonate composition in examples (cols. 6-7) wherein polycarbonate (LEXAN 315), core/shell elastomer (KM653) and a fibril-forming PTFE are taught. Said PTFE has the instant molecular weight inherently, and polycarbonate inherently has the instant viscosity-average molecular weight. Said polycarbonate composition contains 0.5% of sodium trichloro benzene sulfonate and 0.06 wt.% of PTFE (col. 6, lines 45-46 and 58-60). Example 3

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of table 2 show 10 wt.% of KM653, however, the claim 1 teaches employing 4-12 wt.% of an impact modifier which encompasses the instant amount. An overlapping range is an anticipation as well as a prima facie obviousness.

Thus, the instant invention lacks novelty.

Claims 1, 3 and 5-8 rejected under 35 U.S.C. 103(a) as obvious over Liu (US 4,710,534) and JP 10-306208.

JP teaches polycarbonate meeting the instant viscosity-average molecular weight in abstract.

It would have been obvious to one skilled in the art at the time of invention to utilize the polycarbonate having the instant viscosity-average molecular weight taught by JP in Liu since molded articles using such polycarbonate is well known as taught by JP.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/September 8, 2003

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/September 8, 2003